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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

042564

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on _____

Signature _____

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Application Number

10/501,092

Filed

January 25, 2005

First Named Inventor

Katsuya ITOH

Art Unit

1796

Examiner

Alicia Toscano

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 56,868

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Andrew G. Melick

Typed or printed name

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Telephone number

March 30, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Katsuya ITOH**

Art Unit: **1796**

Application Number: **10/501,092**

Examiner: **Alicia Toscano**

Filed: **January 25, 2005**

Confirmation Number: **3054**

For: **POLYESTER FILMS**

Attorney Docket Number: **042564**

Customer Number: **38834**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF

Date: March 30, 2009

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Sir:

This Request is filed concurrent with a Notice of Appeal in compliance with 37 C.F.R. §41.31. Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

REMARKS

Claims 1 and 3-9 are currently pending in the present application.

Claim Rejections – 35 U.S.C. § 102

Claims 1-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by **Majima** (WO 01/092417 as evidenced by U.S. 6,780,482, which is used as an Equivalent English document).

Favorable reconsideration is requested.

(1) Applicant respectfully submits that it was a clear error for the Office Action to not consider the dependency of the compression ratio on the half value width which demonstrates

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that the recited half value width is not inherent in Majima.

The Office Action compares Example 1 and Comparative Example 1 of the specification and concludes that for a PET/silica and PBT/phosphorous 40/60 mixture processed at a compression ratio of 1.5, a temperature less than 285°C is required for satisfying the half value width as recited in the claims. The Office Action takes the position that Majima satisfies the composition and temperature requirement, and concludes that “as the processing conditions are met, Examiner finds the half value width of the recrystallization peak to be inherent in Majima.” (Office Action, page 4.)

However, as demonstrated in the specification, the compression ratio is also a processing condition that must be satisfied to obtain the recited half value width. As stated in the Amendment of September 19, 2008, a comparison of Example 1 and Example 3 demonstrates the effect of the compression ratio. (See Amendment, September 19, 2008, page 8.) The Examples had the same processing conditions except for compression ratio of extruder III. (Specification, page 24, lines 20-25.) Thus, a comparison of Example 1 and Example 3 demonstrates the effect of the compression ratio on the resulting half value width. The half value width for Example 1 satisfied claim 1, but the half value width of Example 3 did not satisfy claim 1. Thus, evidence in the record establishes that the half value width depends on compression ratio (among other factors such as composition and temperature).

The Office Action acknowledges that Majima is silent about compression ratio, (Office Action, page 2), and the specification demonstrates that compression ratio is a critical factor for obtaining the recited half value width. Furthermore, Applicant submitted data in a declaration on

December 19, 2007 demonstrating an Example from Majima that does not satisfy the recited half value width. Thus, it was clearly erroneous for the Office Action to assume that Majima necessarily satisfies the recited half value width based only on the disclosed composition and temperature in Majima.

(2) Applicant respectfully submits that it was a clear error for the Office Action to require a demonstration of non-inherency throughout the entire scope of the claims.

When relying on inherency, the Patent Office “must make clear that the missing descriptive matter is necessarily present in the thing described *in the reference*, and that it would be so recognized by persons of ordinary skill.” MPEP § 2112(IV) citing *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999) (emphasis added). A *prima facie* case based in part on inherency can be rebutted “by evidence showing that the *prior art products* do not necessarily possess the characteristics of the claimed product.” MPEP § 2112.01(I) citing *In re Best*, 562 F.2d at 1255 (Fed. Cir. 1985). Thus, Applicant can rebut a rejection based on inherency by demonstrating that the prior art reference does not necessarily possess the alleged inherent feature. There is no requirement to demonstrate non-inherency throughout the entire scope of the claim.

The Office Action compares Example 1 to Example 3 of the present specification and concludes that for the conditions in these examples, the compression ratio must be less than 4.0 for satisfying the half value width as recited in the claims. (Office Action, page 2.) The Office Action acknowledges that Majima is silent about compression ratio. But the Office Action takes the position that this result is not commensurate in scope with the claims and the Office Action requires data demonstrating non-inherency throughout the entire scope of the claim. (Office

Action, page 2.)

To rebut the Office Action's allegation of inherency in Majima, Applicant has provided evidence demonstrating that films in Majima do not necessarily possess the recited half value width. A declaration was submitted on December 19, 2007 demonstrating that the half value width property is not inherent even if the compositional limitations are otherwise satisfied, and that when using a conventional extruder for processing a PET film, the composition in Majima itself does not possess the recited half value width.

Applicant has provided sufficient evidence to demonstrate that the recited half value width is not inherent in Majima, and it was clearly erroneous for the Office Action to require a demonstration of non-inherency throughout the entire scope of the claims.

(3) Applicants respectfully submit that it was a clear error for the Office Action to require the claims to recite silica and phosphorous for the Examples of the specification to be commensurate in scope with the claims.

The Office Action states that the Examples in the specification are not commensurate in scope with the claims because the claims do not require silica and phosphorous. (Office Action, pages 2 and 3.)

However, the claims do not exclude silica or phosphorous. Furthermore, the cited Examples and Comparative Examples demonstrate that silica and phosphorous additives are not determinative components for satisfying the recited half value width. All of the Examples and Comparative Examples cited by the Examiner (Examples 1, 3 9 and Comparative Example 1) use silica and phosphorous additives. Moreover, Majima discloses the use of silica and phosphorous

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additives (col. 6, line 62 to col. 7, line 6; col. 9, lines 1-3; col. 11, lines 22-29; col. 16, lines 41-47), which further supports the similarity of the Examples in the present specification with those in Majima.

Thus, the cited Examples and Comparative Examples highlight the effects of temperature and compression ratio on the half value width, while keeping the effects of additives constant, and it is clearly erroneous for the Office Action to require the claims to recite silica and phosphorous for the Examples to be commensurate in scope with the claims.

For the above reasons, it is respectfully submitted that Majima does not teach or suggest the subject matter of claims 1 and 3-9 either expressly or inherently, and it is requested that the rejection be reconsidered and withdrawn.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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